

SUMMARY OF RESTRICTION REQUIREMENT
AND SPECIES ELECTION

The Restriction Requirement stated as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 2, and 18 and 22-23, drawn to a method of collecting data for estimating susceptibility to periodontal disease, classified in class 435, subclass 6.

II. Claims 3-17, drawn to polynucleotides, classified in class 536, subclass 24.3. This group is subject to further restriction.

The Restriction Requirement continued that Group 2 is subject to further restriction wherein the Restriction Requirements states that "This is **NOT** an election of species". In particular, the Restriction Requirement stated the following:

The Applicant is required to elect a specific primer set and specific mutation or specific set of mutations that correspond to the elected primer set for the prosecution of group 2. This is NOT an election of species.

The Restriction Requirement further stated that the claims not drawn to the elected primer set and mutation(s) will be withdrawn from consideration wherein generic polynucleotide claims, such as claim 3, will not be limited by this election.

But paradoxically, the Restriction Requirement stated that the election of a primer set and mutation(s) is **NOT** an election of species. Hence, Applicants cannot properly respond to the requirement of a primer set and mutation(s) given that it appears that the Restriction Requirement is improperly requiring restriction between the members of a properly claimed Markush group.

PROVISIONAL ELECTION

Applicants provisionally elect with traverse Group II, claims 3-17 as stated in the Restriction Requirement.

With respect the restriction between a primer set and mutation(s), Applicants have not made an election of a primer set and mutation(s) given that the election is an improper restriction between members of a Markush group.

In particular, the Restriction Requirement admits on the record that the restriction is not an "election of species". Hence, the only proper requirement that appears to have been made is the restriction between a group 1 and a group 2.

**TRAVERSAL OF ELECTION OF
PRIMER SETS AND MUTATION(S)**

Applicants respectfully traverse the restriction to an election of a primer set and mutation(s) because the requirement for restriction is not proper where the restriction is applied towards members of a Markush group within a single claim.

In particular, restriction is governed by 35 U.S.C. § 121, which provides:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

Therefore, the statute allows restriction where there are two or more inventions within an application.

However, the statute does not provide for restriction where there are allegedly two or more inventions within a claim. Claims by their very nature cover multiple members such as within a properly claimed Markush group. Hence, it is not proper to require restriction within a single claim merely because it contains multiple Markush members. If this were true, Markush claim could not be properly claimed. The principle is explained in In re Weber:

Ever since Ex parte Eagle, 1870 C.D. 137

(Com'r Pats. 1870), at least, the expression used in § 121 "two or more *** inventions are claimed," has connoted separate claims to separate inventions. It has no reference to generic or broad claims which "embrace" (the term used by the examiner and the board herein) or "cover" (the term used in the solicitor's brief in support of the board) two or more inventions.

* * *

The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim "embraces" or "covers" a multiplicity of inventions, in the sense of "dominating" them, which inventions might be separably patentable if and when presented in separate applications. In re Weber, 580 F.2d 455, 459-460 (C.C.P.A. 1978) (emphasis added).

The M.P.E.P. provides specific rules pertaining to Markush style claims as in the present case wherein restriction requirements must accommodate the holding of In re Weber as follows in MPEP § 803.02:

This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members . . . In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. . . . should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended . . . to the extent necessary to determine patentability of the Markush-type claim. M.P.E.P. § 803.02 (emphasis added).

In view of the In re Weber holding, a restriction is not

proper, but rather a provisional election may be required where a claim contains alternative language. However, in the present case, the Restriction makes clear that the requirement is NOT a species election. Hence, Applicants cannot properly respond to the requirement.

Moreover, the assessment that a "serious burden" is placed on the Patent Office and would likely result in examining different claims is highly subjective and not amenable to precise formulation. Applicants submit that there is no serious burden in examining all the species of the claims because of the commonalities and equivalences between all the claimed species being primer sets having similar function and because of the ease in interpreting and searching each of the primer sets within the claimed Markush group.

Accordingly, Applicants respectfully submit that the restriction between primer sets is improper and request and reconsideration and withdrawal of the restriction.